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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,514	06/23/2005	Takenori Osada		6643

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EXAMINER

LIU, BENJAMIN T

ART UNIT PAPER NUMBER

2826

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/540,514

Applicant(s)

OSADA ET AL.

Examiner

Benjamin T. Liu

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.


- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/23/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

  
**Minhloan Tran**  
**Primary Examiner**  
**Art Unit 2826**

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/23/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

With regard to claim 5, a dependent claim with a preamble for "a method for manufacturing the compound semiconductor epitaxial substrate" cannot be used when the preamble for the independent claim is "a compound semiconductor epitaxial substrate".

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C 102(e) as being anticipated by Mukai et al. (6,639,254).

With regard to claim 1, figures 1-3 of Mukai et al. disclose a compound semiconductor epitaxial substrate for use in a strain channel high electron mobility field effect transistor, comprising an InGaAs layer 24 as a strain channel layer and an AlGaAs layer 21 containing n-type impurities as an electron supplying layer, wherein the InGaAs layer 24 has an emission peak wavelength at 77 K of 1030 nm or more as shown in figure 2. The InGaAs layer 24 in figure 3 is made up of the InGaAs layer 4 in figure 1 so the graph in figure 2 would be representative of how the InGaAs layer in 24 in figure 3 would behave. The graph in figure 2 shows that at an Indium composition of  $x = 0.3$  would produce an emission peak wavelength at 77k of 1030nm or more. (Note lines 35-38 in column 6 of Mukai et al.)

With regard to claim 2, figures 1-3 of Makai et al. disclose a compound semiconductor epitaxial substrate, wherein GaAs layers (22, 25) are provided as spacer layers in contact with a top surface and a bottom surface of said InGaAs layer 24, respectively.

With regard to claim 3, figures 1-3 of Makai et al. disclose a compound semiconductor epitaxial substrate, wherein each of the GaAs layers 22, 25 has a thickness of 4 nm or more. (Note lines 36 in column 4 and lines 14-26 in column 6 of Makai et al.)

With regard to claim 4, figures 1-3 of Makai et al. inherently disclose a compound semiconductor epitaxial substrate, wherein the InGaAs layer 24 has an electron mobility at 300 K of  $8300 \text{ cm}^2/\text{V}\cdot\text{s}$  or more, because the InGaAs layer 24 is composed of a composition of Indium of  $x = .3-.6$  with a surrounding GaAs spacer layer of 4 nm

Art Unit: 2826

thickness or more which matches the Applicants specifications to produce an electron mobility of  $8300 \text{ cm}^2/\text{V}\cdot\text{s}$ . (Note lines 8-9 in column 5 of Makai et al.)

With regard to claim 5, Applicant's claim does not distinguish over the Makai et al. reference regardless of the process used to form the compound semiconductor because only the final product is relevant, not the process of making such as **"employing a metalorganic chemical vapor deposition(MOCVD) method."**

Note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); and In re Marosi et al., 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above caselaw makes clear. See also MPEP 706.03(e).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin T. Liu whose telephone number is (571) 272-6009. The examiner can normally be reached on Mon-Fri 9:30 AM-6:00AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571 272 1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/14/06

BTL